

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

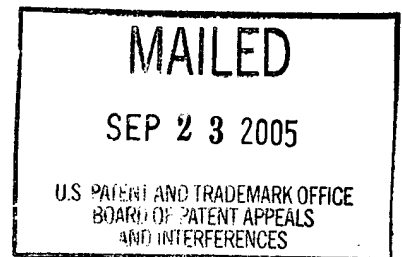
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON JAMES HOOPER, JERRY FRAIN, and JAMES F. KELTON

Appeal No. 2004-1371
Application No. 09/213,907

ON BRIEF



Before HAIRSTON, GROSS, and SAADAT, **Administrative Patent Judges.**

GROSS, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

In accordance with the provisions of 37 C.F.R. § 41.50(a)(1) and the **Manual of Patent Examining Procedure** (MPEP) § 1211 (Eighth Edition, Revision 2, May 2004), this application is remanded to the examiner for an additional response.

Appellants' invention relates to a method for managing a given application type. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method of managing a set of clients in a distributed computer network having a management server, comprising the steps of:

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associating a manager object to each application type on a given client, the manager object including a registry having a set of one or more elements, wherein each element includes information representing a context of an application instance; and

managing all instances of the application through the manager object.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Khoyi et al. (Khoyi)	5,261,080	Nov. 09, 1993
Bereiter	5,754,763	May 19, 1998
Jeffords et al. (Jeffords)	6,233,623	May 15, 2001

(filed Jan. 11, 1996)

Claims 1, 4 through 10, 15 through 17, and 19 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Khoyi in view of Jeffords.

Claims 2, 3, 11, 12, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Khoyi in view of Jeffords and Bereiter.

In the Final Rejection (mailed November 20, 2002), the examiner indicated that claims 1 through 23 were pending and that all 23 claims were rejected. However, the statement of the rejection over Khoyi in view of Jeffords, on page 3 of the Final Rejection, stated that claims 1, 10, 17, 22, and 23 were rejected, and the statement of the rejection over Khoyi in view of Jeffords and Bereiter, on page 5 of the Final Rejection, stated that claims

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2, 3, 11, 12, and 18 were rejected. In other words, claims 4 through 9, 13 through 16, and 19 through 21 were not indicated as being rejected. However, the examiner did discuss claims 4 through 9, 15, 16, and 19 through 21 on pages 4-5 of the Final Rejection as being disclosed by the combination of Khoyi and Jeffords. Claims 13 and 14, though, were never mentioned by the examiner except on the cover page.

Appellants noted in bold at pages 4-5 of the Brief that claims 4 through 9, 13 through 16, and 19 through 21 were not included in any statement of the rejection and that claims 13 and 14 "fail to appear in any of the arguments for the rejections while also failing to appear in the statement of the grounds of rejection." Appellants questioned whether claims 13 and 14 were allowable.

In the Examiner's Answer, the examiner fails to respond to appellants' question as to the allowability of claims 13 and 14. Instead, the examiner again omits claims 4 through 9, 13 through 16, and 19 through 21 from the statement of the rejection and again omits claims 13 and 14 from both the statement of the rejection and the arguments for rejection. Thus, it is unclear to us what is the status of all of claims 4 through 9, 13 through 16, and 19 through 21, but particularly claims 13 and 14.

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In addition, we note that on page 4 of the Brief, appellants list as one of the issues the rejection of claims 2, 3, 11, 12, and 18. However, appellants fail to mention claims 2, 3, 11, 12, and 18 in the grouping of the claims or in the arguments. Therefore, it is unclear whether appellants have conceded the rejection of these claims or mean for them to stand or fall with the claims from which they depend.

Accordingly, it is ORDERED that the application is remanded to the examiner for the following actions: (1) to clearly indicate which claims are rejected, thereby clarifying the status of claims 4 through 9, 13 through 16, and 19 through 21, and (2) obtain clarification from appellants as to the status of claims 2, 3, 11, 12, and 18. Note, if claims 13 and 14 are rejected, the examiner must indicate where the limitations of claims 13 and 14 can be found in the references.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01 (Eighth Edition, Revision 2, May 2004), item (D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REMANDED

KENNETH W. HAIRSTON
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

MAHSHID D. SAADAT
Administrative Patent Judge

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